

## REMARKS

The present application has been reviewed in light of the Office Action dated March 4, 2009. Claims 34-42 are presented for examination, of which Claims 34, 37, and 40 are in independent form. Claims 34-42 have been amended to define aspects of Applicant's invention more clearly. Favorable reconsideration is respectfully requested.

The Office Action states that the specification is objected to as failing to provide proper antecedent basis for the phrase "computer-usable medium having control logic" recited in Claims 40-42. In response, independent Claim 40 has been amended to be directed to a "computer-readable storage medium having stored therein a computer-executable program for causing a communication apparatus to implement a control method . . ." In addition, the specification has been amended accordingly. No new matter has been added, because the original version of the now-amended paragraph stated explicitly that the stored programs are executed by a CPU.

The Office Action states that Claims 34-36 and 40-42 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. In response, independent Claim 34 has been amended to recite a "central processing unit" and "a memory unit coupled to the central processing unit." Independent Claim 40 has been amended to be directed to a "computer-readable storage medium having stored therein a computer-executable program for causing a communication apparatus to implement a control method . . ." In addition, Claims 41 and 42 have been amended along the lines of the changes made to Claim 40. It is believed that the rejections under Section 101 have been obviated and their withdrawal is therefore respectfully requested.

The Office Action states that Claims 34-42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,400,719 (*Chimura et al.*) in view of U.S. Patent No. 5,940,598 (*Strauss et al.*) in view of U.S. Patent Application Publication No. 2004/0139209 (*Mussman et al.*) and further in view of U.S. Patent Application Publication No. 2002/0095516 (*Nada*). For at least the following reasons, Applicant submits that independent Claims 34, 37, and 40, together with the claims dependent therefrom, are patentably distinct from the cited prior art.

Claim 34 is directed to a communication apparatus that includes a facsimile communication unit that performs facsimile communication on a line switching network and an Internet Protocol (IP) communication unit, that transmits communication data to a communication partner station discriminated by a telephone number, and that receives communication data from the communication partner station. The apparatus also includes a central processing unit, a memory unit, an IP address obtaining unit, a control unit, and a determination unit. The IP address obtaining unit obtains an IP address of the communication partner station from a Session Initiation Protocol (SIP) proxy server, based on a telephone number of the communication partner station. The control unit establishes a Voice over IP (VoIP) communication channel on an IP network according to the IP address of the communication partner station obtained by the IP address obtaining unit, and transmits an image transmission request message prior to transmission of image data.

Notably, the determination unit determines, based on contents of an image transmission permission message received from the communication partner station in response to the image transmission request message, whether transmission and reception of communication data can be performed on the IP network using a predetermined file transmission protocol. If the

determination unit determines that transmission of communication data on the IP network based on the predetermined file transmission protocol can be performed, the control unit starts transmission of the image data between the communication apparatus and the communication partner station on the IP network based on the predetermined file transmission protocol using the obtained IP address of the communication partner station. If the determination unit determines that transmission of the communication data on the IP network based on the predetermined file transmission protocol cannot be performed, the control unit causes the facsimile communication unit to start transmission of the image data using analog facsimile communication via the VoIP communication channel.

In addition, if the determination unit determines that reception of the communication data on the IP network based on the predetermined file reception protocol can be performed, the control unit starts reception of the image data between the communication apparatus and the communication partner station on the IP network based on the predetermined file reception protocol using the obtained IP address of the communication partner station. If the determination unit determines that reception of the communication data on the IP network based on the predetermined file reception protocol cannot be performed, the control unit causes the facsimile communication unit to start reception of the image data using analog facsimile communication via the VoIP communication channel.

Applicant agrees with the Examiner's conclusion that a combination of *Chimura et al.*, *Strauss et al.*, and *Mussmand et al.* fails to disclose a feature wherein, in a case where transmission of the communication data on the IP network based on the predetermined file transmission protocol cannot be performed, the control unit causes the facsimile communication

unit to start transmission of the image data using analog facsimile communication via the VoIP communication channel, and in a case where reception of the communication data on the IP network based on the predetermined file reception protocol cannot be performed, the control unit causes the facsimile communication unit to start reception of the image data using analog facsimile communication via the VoIP communication channel (*see* Office Action, page 8). The Office Action, however, asserts that these features are disclosed by *Nada*.

*Nada* is understood to relate to an Internet telephone system and an Internet telephone apparatus (*see* paragraph 1). *Nada* discusses that the system uses only a telephone number entered into the Internet telephone to communicate with a partner, without having to judge whether a telephone of the partner is accessible to the Internet (*see* paragraph 28). *Nada* also discusses that a telephone number of a destination side telephone set 11 is entered in a calling side telephone set 2 and that a modem 1 accesses a server 7 to check whether an IP address corresponding to the telephone number is present (*see* paragraphs 52 and 58). If the modem 1 does not receive a response from the server 7 within a predetermined time an operation is executed (*see* paragraphs 52 and 58).

*Nada* also discusses that the modem 1 uses a received IP address to send a connection request to a destination side modem 10 (*see* paragraph 64). If a response from the destination side modem 10 is not received within a predetermined time, a controller 13 changes a transmission line switch 19 from an audio processor 17 side to a Public Switching Network (PSN) interface 14 side, which causes a call to be made to the partner through the PSN (*see* paragraph 64).

Nothing has been found in *Nada* that is believed to teach or suggest that the

modem 1 selects a particular network or protocol for transmitting image data based on contents of a response to the connection request. Moreover, nothing has been found in *Nada* that is believed to teach or suggest that image data is transmitted and received by analog facsimile communications over a VoIP communication channel.

In summary, Applicant submits that a combination of *Chimura et al.*, *Strauss et al.*, *Mussman et al.*, and *Nada*, assuming such combination would even be permissible, would fail to teach or suggest a communication apparatus that includes “a determination unit adapted to determine, based on contents of an image transmission permission message received from the communication partner station in response to the image transmission request message, whether transmission and reception of communication data can be performed on the IP network using a predetermined file transmission protocol, wherein, if the determination unit determines that transmission of communication data on the IP network based on the predetermined file transmission protocol can be performed, the control unit starts transmission of the image data between the communication apparatus and the communication partner station on the IP network based on the predetermined file transmission protocol using the obtained IP address of the communication partner station, and, if the determination unit determines that transmission of the communication data on the IP network based on the predetermined file transmission protocol cannot be performed, the control unit causes the facsimile communication unit to start transmission of the image data using analog facsimile communication via the VoIP communication channel, and wherein, if the determination unit determines that reception of the communication data on the IP network based on the predetermined file reception protocol can be performed, the control unit starts reception of the image data between the communication apparatus and the

communication partner station on the IP network based on the predetermined file reception protocol using the obtained IP address of the communication partner station, and, if the determination unit determines that reception of the communication data on the IP network based on the predetermined file reception protocol cannot be performed, the control unit causes the facsimile communication unit to start reception of the image data using analog facsimile communication via the VoIP communication channel,” as recited in Claim 34.

Accordingly, Applicant submits that Claim 34 is patentable over *Chimura et al.*, *Strauss et al.*, *Mussman et al.*, and *Nada*, whether considered separately or in combination, and respectfully requests withdrawal of the rejection of Claim 34 under 35 U.S.C. § 103(a). Independent Claims 37 and 40 include features similar in many relevant respects to those of Claim 34 and are believed to be patentable over *Chimura et al.*, *Strauss et al.*, *Mussman et al.*, and *Nada*, whether considered separately or in combination, for at least the reasons discussed above.

The other rejected claims in the present application depend from one of independent Claims 34, 37, and 40 and are submitted to be patentable over *Chimura et al.*, *Strauss et al.*, *Mussman et al.*, and *Nada* for at least the same reasons. Because each dependent claim also is deemed to define an additional aspect of the invention, individual reconsideration of the patentability of each claim on its own merits is respectfully requested.

This Amendment After Final Action is believed clearly to place the present application in condition for allowance. Therefore, entry of this Amendment under 37 C.F.R. § 1.116 is believed proper and is respectfully requested, as an earnest effort to advance prosecution and reduce the number of issues. Should the Examiner believe that issues remain outstanding, it is respectfully requested that the Examiner contact Applicant’s undersigned

attorney in an effort to resolve such issues and advance the case to issue.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and an early passage to issue of the present application.

No petition to extend the time for response to the Office Action is deemed necessary for this Amendment. If, however, such a petition is required to make this Amendment timely filed, then this paper should be considered such a petition and the Commissioner is authorized to charge the requisite petition fee to Deposit Account 06-1205.

Applicant's undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

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